

REMARKS

In view of the foregoing amendments and following remarks responsive to the Office Action of July 19, 2005, Applicant respectfully requests favorable reconsideration of this application.

Claims 1-4, 8-10, and 31 were pending in this application. Claims 5-7, 11-30, and 32-42 were withdrawn due to a previous restriction requirement.

Applicant has herein amended pending claims 1, 2, 9, and 31, cancelled pending claim 8, amended withdrawn claims 12, 13, 19, and 32, and cancelled withdrawn claims 5-7. Accordingly, claims 1-4, 9-10, and 31 are now pending in this application.

The Office has asserted two provisional double patenting rejections, the first rejecting all claims over claims at 1-46 of U.S. patent application publication number 2004/0051603, and the second one rejecting all claims over US patent application publication number 2004/0051602. The rejections are provisional since neither of these applications have been patented.

Applicants will gladly file a terminal disclaimer over one or both of these applications in order to overcome these rejections, as may be needed in the future. However, Applicant respectfully requests the Office to hold any double patenting issue in abeyance until an indication of allowable subject matter, as claim breadth may change during prosecution.

The Office further rejected all claims under 35 U.S.C. 102(e) as being anticipated by Pance. The Office correctly noted that the Pance reference has a common assignee with the instant application and noted that applicant can

overcome this rejection by showing under 37 C.F.R. 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another".

This is in fact the case in the current situation. Accordingly, attached hereto is a declaration under 37 CFR 1.132 attesting to the fact that the invention claimed in the currently pending claims of the present application was the work solely of the inventors named in the present application.

The Office further rejected (1) claims 1-3 and 31 under 35 U.S.C. 102 (b) over either of DeMaron or Etienne, (2) claims 1-3 under 35 U.S.C. 102 (b) over Delestre, (3) claim 4 under 35 U.S.C. 103(a) over any of DeMaron, Etienne, or Delestre in view of Mayer or Kishk, (4) claim 8 under 35 U.S.C. 103(a) over any of DeMaron, Etienne, or Delestre in view of Nishikawa, and (5) claims 9-10 under 35 U.S.C. 103(a) over any of DeMaron, Etienne, or Delestre in view of Nishikawa and further in view of Tanaka.

Applicant has herein amended the claims so as to incorporate the recitations of claim 8 into each of the independent claims 1 and 31. Accordingly, all of the prior art rejections other than the rejection of claim 8 are now moot.

Applicant respectfully traverses the rejection of claim 8.

The present invention comprises a technique and associated mechanisms for implementing a technique by which dielectric resonator circuits, such as filters, can be tuned in both frequency and bandwidth without the need for irises, tuning screws, and/or tuning plates. This helps to substantially reduce insertion

loss and improve Q in the circuit because of the elimination of conductive components within the fields of the dielectric resonators.

In accordance with the particular species of the invention elected for prosecution in this application, the positions of the dielectric resonators (or at least some of them) are adjustable relative to each other within the cavity at least along the longitudinal axes of the dielectric resonators. The dielectric resonators can be positioned relative to each other so that they overlap in the vertical dimension.

The particular claim recitation at issue with respect to former claim 8 and now independent claims 1 and 31 is the issue of whether "said dielectric resonators are positioned relative to each other so that they overlap each other in a plane parallel to said longitudinal axes". The Office asserted that this is taught by Nishikawa and that it would have been obvious to incorporate this teaching of Nishikawa into any one of the primary references. Specifically, the Office conceded that none of the primary references shows that the dielectric resonators overlap each other in the longitudinal direction. However the Office asserted that Nishikawa discloses a circuit in which the dielectric resonators overlap each other in the longitudinal direction and that it would have been obvious to position the dielectric resonators to overlap in any of the primary references as an alternate way to provide the plurality of dielectric resonators as shown by Nishikawa.

Applicant respectfully traverses. Nishikawa does not disclose that the dielectric resonators overlap each other in the longitudinal direction. Specifically,

the Office referred to figure 11 of Nishikawa and particularly dielectric resonators 20A-20E as disclosing this feature. However, in figure 11 of Nishikawa, the longitudinal direction is the direction perpendicular to the page. In other words, figure 11 is a plan view of the circuit in which the viewer is looking at the circuit straight down in the longitudinal direction. Thus, if a first dielectric resonator overlapped a second dielectric resonator in the longitudinal direction, as claimed in claims 1 and 31, the first resonator would occlude the second resonator in the plan view of figure 11. Quite clearly, one can see the entirety of each of the dielectric resonators 20A-20E in figure 11 of Nishikawa. Therefore, quite clearly, the dielectric resonators 20A-20E do not overlap each other in the longitudinal direction in Figure 1 of Nishikawa.

Accordingly, independent claims 1 and 31 patentably distinguish over the prior art of record.

Since all other pending claims depend from one or the other of claims 1 and 31, they also distinguish over the prior art for at least the same reasons.

Also note that, since independent claims 1 and 31 are in allowable condition, withdrawn dependent claims 11-30 and 32-36 should now be rejoined in this application and also are allowable for at least all of the reasons that independent claims 1 and 31 are allowable. Dependent withdrawn claims 5-7 were inconsistent with independent claim 1 as newly amended and, therefore, Applicant has cancelled them from the application. Applicant also has amended withdrawn claims 12, 13, 19, and 32 to make them consistent with the

amendments to the other pending claims since they will now be rejoined in this application.

Accordingly, as presently presented, claims 1-4, and 9-36 patentably distinguish over the prior art of record.

In view of the foregoing amendments and remarks, this application is now in condition for allowance. Applicant respectfully requests the Examiner to issue a Notice of Allowance at the earliest possible date. The Examiner is invited to contact Applicant's undersigned counsel by telephone call in order to further the prosecution of this case in any way.

Respectfully submitted,

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Enclosures

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